

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 21-38 are requested to be cancelled without prejudice or disclaimer and new claims 39-50 are added. New claims correspond to previous claims as follows: 39 to 21, 40 to 22, 41 to 27, 42 to 28, 43 to 28 and the specification on page 25, lines 1-24 and page 27, line 1-16, 44 to 31, 45 to 32, 46 to 33, 47 to 34, 48 to 35, 49 to 36 and 50 to 37.

Claims 39, 40, 41, 42 and 43 reflect changing “comprising” to “consisting of.” The claims have been amended to more clearly define the present invention, and should not be construed as the surrender of any subject matter. Applicants reserve the right to file one or more continuing applications on any canceled subject matter. The amended claims have support in the original claims and specification as filed.

This amendment adds and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 39 to 50 are now pending in this application.

1. Rejection under 35 U.S.C. § 112, second paragraph
Claims 23-26

Claim 23-26 are rejected as allegedly being indefinite because the Examiner considers the phrase “stringent conditions” to be unclear. Although applicants believe that the term “under stringent conditions” is well known to persons skilled in the field of molecular biology. DNA Science by Micklos and Freyer (1990) defines “stringency” in the Glossary/Index, page 475 (copy enclosed) as “reaction conditions—notably temperature, salt, and pH—that dictate the annealing of single-stranded DNA/DNA, DNA/RNA, and RNA/RNA hybrids,” applicants have canceled these claims in an effort to expedite prosecution. Therefore, in view of these claim amendments, it is requested that this rejection be withdrawn.

Claims 29-31, 37 and 38

Claim 29-31, 37 and 38 are rejected as allegedly being indefinite because the Examiner considers the phrase “immunologically active fragment” in these claims to be indefinite. Applicants submit that one skilled in the art would know that an “immunologically active fragment” is a fragment which is immunogenic, which means that it is capable of stimulating an immune response in a mammal. Applicants particularly refer the Examiner to the Examples in the specification, beginning on page 25, line 26, where the two peptides claimed in claim 44 (previously claim 31), are used to immunize rabbits. Immune sera from these rabbits are collected and purified and tested for immunoreactivity against h-sgk. In an effort to expedite prosecution, applicants have deleted the rejected phrase and inserted in its place, the term “immunogenic.” Applicants provide two dictionaries, A Dictionary of Genetics, 6th Ed., R. King and W. Stansfield, Eds., Oxford University Press, page 201 (2002); and Dorland’s Illustrated Medical Dictionary, 25th Ed., W.B. Sanders Company, page 766 (1974), which define the term “immunogenic” as “capable of stimulating an immune response” or “evoking an immune response,” respectively. Applicants submit that an “immunologically active” fragment means that the fragment is capable of stimulating an immune response or is immunogenic. It is requested that this rejection be withdrawn in regard to claim 44, which corresponds to previous claim 31. Previous claims 29 and 30 have been canceled, which renders the rejection of these claims and the claims that depended from them moot.

2. Rejection under 35 U.S.C. § 112, first paragraph

2.1 Claims 21-38

Claims 21-38 are rejected as failing to comply with the enablement requirement, and the Examiner cites the *Wands* factors in support of the alleged lack of enablement rejection. The Examiner states that previous claims 32-38 are directed to pharmaceutical compositions comprising nucleic acids that encode h-sgk having specific sequences. The Examiner further states that the specification fails to provide an effective dose of the h-sgk nucleic acid required against a specific disease, disorder or condition; guidance as to what disease, disorder or condition the pharmaceutical composition is effective against; and a demonstration of the desired effect of use in an art recognized animal model experiment.

Applicants have canceled previous claims 32-38 and replaced them with claims 45-50, which are no longer directed to a “pharmaceutical composition” but rather are directed to a “composition.... and a pharmaceutically acceptable carrier.” Applicants wish to point out that such language was allowed in the claims of the parent of the present application. See attached front and last page of U.S. 6,326,181, claim 2. Applicants submit that the amendment to the claims overcomes the rejection of previous claims 32-38 (now claims 45-50), and the withdrawal of this rejection is kindly requested.

2.2 Claims 23-26

Claims 23-26 are rejected as non-enabling because the specification allegedly fails to teach an assay for functionally active h-sgk. In an effort to expedite prosecution, applicants have canceled previous claims 23-26 without prejudice or disclaimer. Therefore, it is requested that this rejection be withdrawn.

2.3 Claims 21, 22, 27-30 and 32-37

Claims 21, 22, 27-30 and 32-37 are rejected for lack of enablement because the Examiner alleges that a DNA sequence comprising a fragment of SEQ ID NO:1 a DNA sequence comprising only SEQ ID NOS 3 or 4 or DNA sequences encoding an amino acid sequence consisting of the amino acids 313 to 431 or 980 to 1480 because it allegedly does not comprise enough bases capable of encoding any product with kinase function.

Applicants traverse this rejection and suggest that the Examiner has in fact made a lack of utility rejection by requesting that the claimed nucleic acid sequence comprising a fragment of SEQ ID NO:1 or comprising the less than full-length h-sgk must encode a product with kinase activity. New claims 39 and 40 correspond to previous claims 21 and 22 and these former claims have been amended to delete reference to “a fragment thereof” of the recited sequence and from “comprising” to “consisting of” language. Accordingly, the rejection of claims 39 and 40 should be withdrawn in view of these amendments. In regard to claims 41, 42 and 44 that correspond to the previously rejected claims, applicants wish to point out that the specification discloses the specific amino acid residues which are claimed in these claims. Applicants submit that there is no need to “teach about the structural requirements of DNA sequences comprising said number of bases ...” as claimed in claims 41, 42 and 44 because

these claims recite specific sequences of the complete h-sgk sequences. Applicants contend that disclosure of the primary sequence is sufficient to satisfy enablement of the structure. Further, the Examples support the use of the nucleic acids to encode the peptides of claim 44 that are used as immunogens, for eliciting antibodies, which is a use that does not require that the nucleic acids encode peptides with kinase function. Applicants submit that the claims to specific nucleic acid sequences of a nucleic acid sequence that encodes a polypeptide that possesses kinase activity is sufficient to enable the presently claimed invention. Applicants have disclosed the specific nucleic acids and specifically identified fragments of these nucleic acids so the structural requirements of these nucleic acids have been disclosed and thus enabled. Applicants request that the Examiner reconsider her position and withdraw this rejection against the pending claims.

2.4 Claims 21, 22, 27-30 and 32-37

Claims 21, 22, 27-30 and 32-37 are rejected as allegedly failing to comply with the written description requirement for defining the claimed nucleic acid only by function (previous claim 29) or by a sequence which does not disclose nucleic acids that encode fragments or portions of specific sequences that do not encode any product with kinase function.

Firstly, previous claim 29 has been canceled and new claims 39 and 40 (corresponding to previous claims 21 and 22, respectively) have been amended to delete the phrase “or a fragment thereof.” All of the claims are now directed to specific nucleic acids defined by sequence or a portion of a defined sequence. Claims 39-44 recite specific full length nucleic acid sequences or specifically recited fragments of these full-length sequences using “consisting of” language. Again as argued above, applicants submit that the claim features define the nucleic acids and provide an adequately describe the entire genera as claimed. Applicants believe that the amended claims overcome the Examiner’s rejection and it is requested that this rejection be withdrawn.

2.5 Claims 25 and 26

Claims 25 and 26 are rejected as allegedly failing to comply with the written description requirement. In an effort to expedite prosecution, applicants have canceled these claims and this rejection is moot in view of the accompanying claim amendments.

3. Rejection under 35 U.S.C. § 102(b)

Claims 21, 22, 27-29, 30 and 32-37 are rejected as allegedly being anticipated by Webster *et al.* (*Mol. Cell. Biol.*, 20231-2040, 1993 cited Applicants' IDS, that allegedly discloses a DNA sequence encoding rat sgk which has 97.9% homology to SEQ ID NO:2. As discussed above, the amended claims are directed to nucleic acids that consist of specific nucleotide sequences or consist of portions of these sequences. In view of the amended claims, it is requested that this rejection be withdrawn.

4. Rejection under 35 U.S.C. § 102(b)

Claims 30 and 37 are rejected as allegedly being anticipated by Adams *et al.* (*Nature*, 377 (6547 suppl), 3-174, 1995. Claim 30 and its dependent claim 37 have been canceled, and in view of this amendment, it is requested that this rejection be withdrawn.

5. Rejection under 35 U.S.C. § 102(a)

Claims 21-37 are rejected over Waldegger *et al.*, the inventors' own publication. Applicants provided a copy of the certified translation of the German priority document in the parent application and have provided a copy of this document with this response as a courtesy to the Examiner. In view of the submission of this document, this rejection is moot and should be withdrawn.

6. Allowable Subject Matter

Previous claim 31 (now claim 44) is objected to as depending from a rejected base claim and the Examiner stated that if the claim was written in independent form with the features of the base claim that it would be allowable. Claim 44 is written in independent form and it is requested that this rejection be withdrawn.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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